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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,140	12/15/2000	Toyokazu Sakata	32011-168503	8430

26694 7590 09/08/2003

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT	PAPER NUMBER
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2826

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,140

Applicant(s)

SAKATA ET AL.

Examiner

Alexander O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12,13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Serial Number: 09/734140 Attorney's Docket #: 32011-168503

Filing Date: 12/15/2000; claimed foreign priority to 12/15/99 and 11/13/2000

Applicant: Sakata et al.

Examiner: Alexander Williams

Applicant's RCE in Paper # 16, filed 6/16/03 has been acknowledged.

Applicant's Amendment in Paper # 17, filed 6/16/03 has been acknowledged.

Applicant's Substitute Specification in Paper # 15, filed 6/16/03 has been acknowledged.

This application contains claims 8 to 19 drawn to an invention non-elected without traverse in Paper No. 6.

Claims 4 to 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, it is unclear and confusing to what is meant by "each of said first portions having a width W1 smaller than a width W3 of each of the second portions." What is this W3 and where is it described in the specification and drawings?

In claims 5 to 8, it is unclear and confusing to what is meant by "wherein part of the upper surface of said underlayer constitutes the base wiring area, said holes reaches the base wiring area, and a dispersion protection film is formed only on said base wiring area outside the hole." Where is this shown in the drawings?

Any of claims 4 to 8 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2 and 5, **insofar as claim 5 can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada (U.S. Patent # 6,268,279 B1).

For example, in claim 1, Okada (figures 1A to 6) specifically figure 1B show a semiconductor device, comprising: an underlayer **101**; a base oxide film **103** with holes and formed on the underlayer; a plurality of nitride film patterns (**105 in both sides of the hole**) with a hole pattern formed on the base oxide film and directly connected to said holes respectively; an upper oxide film **104** provided on top of said base oxide film to cover the nitride film pattern, the upper oxide film having formed therethrough an wiring grooves which each reaches part of an associated nitride film pattern including said hole patterns; and wiring metal **106** that fills said first holes, and said wiring grooves; and wherein said nitride film patterns are separate from each other and a shape and size that extends form the outside of their associated wiring groove. Okada fail to explicitly show a plurality of holes in the base oxide film. However, Okada does discloses one device separate from extending from a would be other device. It would be the designers choice to have other device created within the substrate formed.

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As to claim 2, Note that the specification contains no disclosure of either the critical nature of the claimed dimensions or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Therefore, it would be obvious to one of ordinary skill in the art to use the teaching of Okada's device to form a plurality of devices for the purpose of processing a plurality of semiconductor devices on one wafer.

Claim 3 is allowed.

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Any such indication as to the allowability of these claims is reserved until which time a suitable response is filed.

Response

Applicant's arguments filed 6/16/03 have been fully considered, but are moot in view of the new grounds of rejections detailed above.

Field of Search	Date
U.S. Class and subclass: 257/774,700,701,758-765,767,741,750-753,759	9/17/02 3.15.03 8/20/03
Other Documentation: foreign patents and literature in 257/774,700,701,758- 765,767,741,750-753,759	9/17/02 3/15/03 3/20/03
Electronic data base(s): U.S. Patents EAST	9/17/02 3/15/03 8/20/03

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Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.

Any inquiry concerning this communication or any earlier communication from the examiner should be directed to ***Examiner Alexander Williams*** whose telephone number is **(703) 308-4863**.

Any inquiry of a general nature or relating to the status of this application should be directed to the ***Technology Center 2800 receptionist*** whose telephone number is **(703) 308-0956**.

8/20/03



Primary Examiner
Alexander O. Williams